

13. (Twice Amended) A surgical device comprising:

a tissue engaging means including first and second opposed jaws for grasping, securing, and occluding body tissue and conduits;

a handle assembly;

an actuating means connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means; and

a shaft member made of a malleable material and having a proximal end, a distal end and a longitudinal axis, the proximal end of the shaft member coupled to the handle assembly, the distal end of the shaft member coupled to the tissue engaging means, the actuating means extending axially through the shaft member, the shaft member configured to be kink resistant and to bend about some bending radius in response to a bending moment applied to the shaft member, the bending moment applied to the shaft member ranging between 6 in-lbs to 27 in-lbs.

#### REMARKS

This Amendment is in response to the Office Action mailed on 14 January 2003, in which claims 1 and 3 - 12 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,916,193 to *Stevens et al.* Claims 13 and 15 - 21 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,643,303 to *Donahue*. In addition, claims 1, 3 - 12, 13, and 15 - 21 were objected to under 35 U.S.C. § 112, second paragraph, as being indefinite.

With this reply, claims 1, 3 - 12, 13, and 15 - 21 are amended to address the indefinite objections. In addition, claims 1, 3 - 12 have been amended to move the tissue engaging means, handle assembly and actuating means from the preamble to the body of the claims. The claims as amended are set forth in the Appendix.

The Office Action argues that "it is noted that the features upon which applicant relies (i.e. tissue engaging means and a handle assembly and an actuating means) are not recited in [claim 1 and its dependents]." With the present amendment, the tissue engaging means, handle assembly and actuating means are now recited in the body of claim 1 and its dependents. For this reason alone, the rejection of claims 1 and 3 - 12 under *Stevens* should be withdrawn and these claims passed to issuance.

Moreover, what is described in U.S. Patent No. 5,916,193 to *Stevens et al.* is an endovascular device for partitioning the ascending aorta. A “polymeric balloon 330,” not a “tissue engaging means,” is what “is mounted to shaft 322 near distal end 324.” (Column 24, lines 8 – 12). A “triple-arm adapter 364,” not a “handle assembly” is what is “attached to the proximal end 326 of shaft 322.” (Column 29, lines 33 – 34). For all these reasons, the rejection of claims 1 and 3 – 12 under *Stevens* should be withdrawn.

The Office Action further argues that “the Examiner considers elements 50 and 54 in Figure 8 to be first and second opposing jaws” in U.S. Patent No. 5,643,303 to *Donahue*. The totality of the discussion of elements 50 and 54 in *Donahue* is set forth in the paragraph at column 5, lines 4 – 16, set forth below:

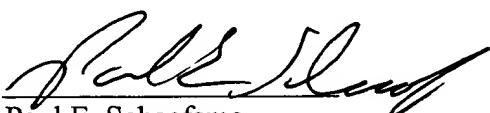
“Referring now to FIGS. 8 and 8A, there is shown a manually operable instrument 40 provided with a flexible length of insertable instrument 42. The outer member or outer tube 44 is provided with a sufficient degree of flexibility between its proximal end 48 and **its distal end 50** to enable it to be manually bent or shaped by a surgeon during an operation, and with sufficient rigidity to retain such bend during the continued performance of the operation. As may be seen best in FIG. 8A, within outer member 44 is an inner member 46 which may be a rod which provides the transmission of force between the handles 52 and **the cutting implement 54**. The inner member 46 may also be a solid or hollow flexible inner member which may transmit the force **to cutting implement 54** by rotation.”

Thus, the Office Action argues that a “distal end” and a “cutting implement” are “first and second opposed jaws for grasping, securing, and occluding body tissue and conduits.” This is far too thin a reed to carry the rejection of claims 13, and 15 – 21.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

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## APPENDIX

1. (Four Times Amended) A [malleable shaft member for a] surgical device [having a tissue engaging means and a handle assembly, and an actuating means connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means, the shaft member] comprising:

a tissue engaging means and a handle assembly;

an actuating means connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means;

a shaft member comprising a first tube made of a malleable material and having a proximal end, a distal end and a longitudinal axis, the proximal end of the first tube adapted to be coupled to the handle assembly, the distal end of the first tube adapted to be coupled to the tissue engaging means, the actuating means adapted to extend axially through the first tube, the first tube configured to be kink resistant [, fatigue resistant,] and to bend about some bending radius in response to a bending moment applied to the first tube, the bending moment applied to the first tube ranging between about 6 in-lbs to 27 in-lbs.

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a tissue engaging means including first and second opposed jaws for grasping, securing, and occluding body tissue and conduits;

a handle assembly;

an actuating means connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means; and

a shaft member made of a malleable material and having a proximal end, a distal end and a longitudinal axis, the proximal end of the shaft member coupled to the handle assembly, the distal end of the shaft member coupled to the tissue engaging means, the actuating means extending axially through the shaft member, the shaft member configured to be kink resistant[, fatigue resistant,] and to bend about some bending radius in response to a bending moment applied to the shaft member, the bending moment applied to the shaft member ranging between 6 in-lbs to 27 in-lbs.